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SAMUEL A. KASSATLY LAW OFFICE
20690 VIEW OAKS WAY
SAN JOSE, CA 95120

EXAMINER

BOSWELL, BETH V

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3623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/091,827
Filing Date: March 06, 2002
Appellant(s): HOSALI ET AL.

Samuel A. Kassatly
(Reg. No. 32,247)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 22, 2009 appealing from the Office action mailed December 7, 2006.

Art Unit: 3623

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-24

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

Art Unit: 3623

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-24 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) recites/recite the following means (or step) plus function limitation: (1) “means for parsing the object into portions that are likely to follow different workflow paths”, (2) means for examining information and an organizational structure contained in each parsed portion, and (3) means for determining an appropriate destination for the object at a lowest possible granularity level within the organizational structure, based on the information and the organizational structure.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification

Art Unit: 3623

an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function: **(1)** Fig 1-2 and page 2, lines 25-30, **(2)** Fig 1-2 and page 3, lines 1-11, and **(3)** Fig 1-2, page 2, lines 16-20 and page 3, lines 13-28, respectively.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function.

With respect to (1), it appears the claimed means are broadly defined on page 2 of the specification and broadly shown in Fig. 1-2. However the specification does not specifically describe how the recited function is performed. Specifically, the specification does not disclose

Art Unit: 3623

one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

With respect to (2), It appears the claimed means are broadly defined on page 3 of the specification and broadly shown in Fig. 1-2. However the specification does not specifically describe how the recited function is performed. Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

With respect to (3), It appears the claimed means are broadly defined on pages 2 and 3 of the specification and broadly shown in Fig. 1-2. However the specification does not specifically describe how the recited function is performed. Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

Claim 24 depends from claim 23 and has the same deficiencies.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-24 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) recites/recite the following means (or step) plus function limitation: (1) “means for parsing the object into portions that are likely to follow different workflow paths”, (2) means for examining information and an organizational structure contained in each parsed portion, and (3) means for determining an appropriate destination for the object at a lowest possible granularity level within the organizational structure, based on the information and the organizational structure.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Art Unit: 3623

“If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function: **(1)** Fig 1-2 and page 2, lines 25-30, **(2)** Fig 1-2 and page 3, lines 1-11, and **(3)** Fig 1-2, page 2, lines 16-20 and page 3, lines 13-28, respectively.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function.

With respect to (1), it appears the claimed means are broadly defined on page 2 of the specification and broadly shown in Fig. 1-2. However the specification does not specifically

Art Unit: 3623

describe how the recited function is performed. Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

With respect to (2), It appears the claimed means are broadly defined on page 3 of the specification and broadly shown in Fig. 1-2. However the specification does not specifically describe how the recited function is performed. Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

With respect to (3), It appears the claimed means are broadly defined on pages 2 and 3 of the specification and broadly shown in Fig. 1-2. However the specification does not specifically describe how the recited function is performed. Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

Claim 24 depends from claim 23 and has the same deficiencies.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 8-9, 11-15, 19-20, 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Bacon et al. (U.S. Patent No. 6430538).

As per claim 1, Bacon et al. teach:

A method of routing an object through a workflow system, comprising:

parsing the object into portions that are likely to follow different workflow paths (see column 9 lines 1-50 and figure 7; where workflow and workflow activities are defined. Each activity is broken down into subflows and branches.);

examining information and an organizational structure contained in each parsed portion (see column 10 lines 10-54 and figure 7; where the server identifies the next activity based on the business process and the just completed activity and pushes the object to the next necessary destination.); and

based on examined information and organizational structure, determining an appropriate destination for the object at a lowest possible granularity level within the organizational structure (see column 4 lines 38-65, column 10 lines 10-54, and figure 7; where the server

Art Unit: 3623

identifies the next activity based on the business process and the just completed activity and pushes the object to the next necessary destination. The server uses process definitions in order to determine the most appropriate destination of the object. The process definitions contain logic that enables the system to isolate the appropriate destination. This use of process definitions and decision agents to route objects is the same as determining the lowest level of granularity to route an object to.); and

routing the object to the appropriate destination (see column 4 lines 38-57; where the server routes a work item to the appropriate agents, clients or work group.).

As per claim 2, Bacon et al. teach:

The method of claim 1, further including examining external information, if any, related to each parsed portion, to further determine the lowest possible granularity level of the object destination (see column 4 lines 39-57; where external activities are examined to determine the status of the workflow and the next possible activity.).

As per claim 3, Bacon et al. teach:

The method of claim 2, further including examining a set of business rules, if any, contained in each parsed portion and related to the organizational structure, to further determine the lowest possible granularity level of the object destination (see column 9 lines 27-38; where specific rule-based branch conditions can be set to further route objects during workflow.).

As per claim 4, Bacon et al. teach:

The method of claim 3, wherein parsing the object into portions includes parsing the object into subsets of information (see column 9 lines 1-50; where workflow is parsed in to

Art Unit: 3623

branches and subflows based on activities, object attributes, and data or information contained in the workflow.).

As per claim 8, Bacon et al. teach:

The method of claim 3, wherein the object includes an intermediate document (see column 2 lines 52-60; where the object or work item is a document. The system accounts for the object data type, coordinating the processing of the object data type such that the data type is usable by all subprocesses. An intermediate document is a file set for processing that is of a data type that the system can read, as per Specification page 5).

As per claim 9, Bacon et al. teach:

The method of claim 3, wherein the object includes a transactional document (see column 2 lines 52-60; where the object or work item is a document. The system accounts for the object data type, coordinating the processing of the object data type such that the data type is usable by all subprocesses. A transactional document is a file used that is processed, i.e. used in transactions, by the workflow system.).

As per claim 11, Bacon et al. teach:

The method of claim 3, wherein the set of business rules includes specific routing rules (see column 9 lines 27-38; where specific rule-based branch conditions can be set to further route objects during workflow.).

Claims 12-15, 19-20, and 22 recite “a computer program for routing an object through a workflow system” taught by Bacon et al. (see column 4 lines 39-65 and column 5 lines 23-48; where the workflow system is a computer program). Claims 12-15, 19-20, and 22 further recite

Art Unit: 3623

limitations already addressed by the rejections of claims 1-4, 8-9, and 11; therefore the same rejections apply to these claims.

Claims 23 and 24 recite “a system for routing an object through a workflow system” taught by Bacon et al. (see column 4 lines 39-65 and column 5 lines 23-48; where a system for routing activities and tasks is disclosed.). Claims 23 and 24 further recite limitations already addressed by the rejections of claims 1-3; therefore the same rejections apply to these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, 10, 16-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon et al. (U.S. Patent No. 6430538).

As per claims 5-7, Bacon does not expressly teach the specific data of “customer information”, “customer credit information”, and “country information”; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. The advantage of capturing this specific data is

Art Unit: 3623

these data types will enable the proper routing of work items based on specific data. For example, data contained in the country field would enable the routing of that work item to a client user that handles that specific country work items. It would have been obvious, at the time of the invention, to incorporate the specific data of “customer information”, “customer credit information”, and “country information” to the Bacon et al. system in order to ensure the proper routing of work items, which is a goal of Bacon et al. (see column 1 lines 27-45).

As per claim 10, Bacon et al. fail to teach “the organization structure includes an organizational hierarchy”. It is old and well-known in the art for the organization structure to include an organization hierarchy. The advantage of the organization structure including an organization hierarchy is that work items can be properly assigned to the persons and resources with the appropriate skills to perform the work item. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to incorporate the feature of “the organization structure includes an organization hierarchy” to properly assign work items to persons and resources with the necessary skills to perform the work item, which is a goal of Bacon et al. (see column 1 lines 40-45).

Claims 16-18 and 21 recite “a computer program for routing an object through a workflow system” taught by Bacon et al. (see column 4 lines 39-65 and column 5 lines 23-48; where the workflow system is a computer program). Claims 16-18 and 20 further recite limitations already addressed by the rejections of claims 5-7 and 10; therefore the same rejections apply to these claims.

(10) Response to Argument

In the Appeal Brief, Appellants sole argument is that Bacon fails to teach “based on examined information and organizational structure, determining the appropriate destination for the object at a lowest possible granularity level within the organization” (emphasis added).

Examiner construes this limitation to mean using data information and an organizational structure, determining the appropriate destination for an object based on the lowest level in the hierarchy of the organizational structure. In other words, for a sales work item in Alexandria, Virginia, the appropriate destination of the work item would be a lowest level available (such as sales representative) on the organization chart for the sales hierarchy in Alexandria, Virginia. The Specification provides no special definition for the term granularity and thus Examiner submits that this interpretation is reasonable.

Bacon explicitly teaches “based on examined information and organizational structure, determining the appropriate destination for the object at a lowest possible granularity level within the organization” (see column 4 lines 38-65, column 9 lines 50-67, column 10 lines 10-54, and figure 7). Bacon describes taking a process flow and parsing the process flow into personal subflows for independent actors in the process flow (see Bacon column 9 lines 50-67). Work items are routed to a decision agent and the decision agent determines which branch (personal subflow) in the workflow the object should be routed to (see Bacon column 9 lines 50-67 and column 10 lines 1-54). Then the decision agent routes the work item to the actor responsible at the subflow for performing the work item (see Bacon column 10 lines 1-54). Examiner submits that these specific teachings from Bacon explicitly reads on the recited feature of “based on examined information and organizational structure, determining the appropriate destination for the object at a lowest possible granularity level within the organization” of the present invention.

Art Unit: 3623

Appellants further argue that Bacon fails to use the term “granularity”. Although Bacon does not use the term “granularity”, Bacon clearly describes the functionality of determining the lowest level of granularity as discussed above. Examiner further submits that Appellants are reviewing the Bacon reference in a vacuum without considering the teachings of the reference as a whole. This is evidenced by Appellants reproduction of Bacon column 4 lines 38-65 teaching the high-level teachings of object routing (see Appeal Brief p. 10) without considering the specific teachings of determining the lowest level of object routing discussed in Bacon column 9 lines 50-67 and column 10 lines 1-54. Examiner maintains that a review of all of the cited portions of Bacon taken as a whole explicitly read on the recited claims of the present invention.

In conclusion, Appellants’ argument has been fully considered, but is not found persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other

Art Unit: 3623

evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Respectfully submitted,

Art Unit: 3623

Kalyan Deshpande /bvb/ for
Patent Examiner
Art Unit 3623

Conferees:

Vincent Millin /bvb/ for
Appeals Conference Specialist
Art Unit 3627

/Beth V. Boswell/
Supervisory Patent Examiner, Art Unit 3623